UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,089	01/28/2002	Masahiko Murakami	1405.1056	9433

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EXAMINER
PLUCINSKI, JAMISUE A

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3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 March 2010*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3.   Claims 1-6, 9, 11-17, 19, 20, 22 and 23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Estes et al. (US 2003/0208411) in view of Franklin et al. (6,125,352) and

Sigler et al. (7,636,696).

4.   With respect to Claims 1, 12 and 23: Estes discloses the use of an address data

management method (and system with means for) comprising the steps:

      a.   Acquiring delivery address data from a user wishing to purchase an item

      (Reference numeral 604);

b.   Establishing a unique address ID which is encrypted (Token being encrypted and representative of the delivery address, See Figure 7) according to a request for issuing an address ID from said purchaser (when a user is registered with the system it is a request for the unique address ID, Estes discloses a registration request from the user, reference numeral 502 with corresponding detailed description) and notifying the user of such ID (See Reference Numeral 606);

c.   Managing a table between address data and address IS (Paragraph 0059, discloses a database which stores user information, the examiner considers a database to be a form of a table);

d.   Accepting delivery request data from a vendor (Reference numerals 610,614) based upon a delivery request from the purchaser where purchasers have supplied the merchant with the address ID (Reference numeral 612);

e.   Looking up the address ID in the table and extracting deliver address (Reference numeral 620 and Paragraph 0012);

f.   Executing delivery processing based on the delivery address, extracted from the table and delivering article (Reference Numerals 622 and 630).

5.   Estes however, fails to disclose the acquiring step capable of storing a plurality of delivery addresses, including addresses of non-purchasers, establishing a unique address ID for each of the delivery addresses. Franklin discloses the use of a Friendly name finder, in which a user can enter in a plurality of addresses, each associated with a nickname, which the examiner considers to be a form of a unique ID, and discloses the nicknames can be for addresses other than the user's (Figure 9 and 11, Reference numerals 942, 944, 952, 954, 1110, 1112, 1114 and

1110 with corresponding detailed description). The examiner considers this to be the correspondence table including the delivery addresses of the purchaser and the non-purchaser. This is done all the time when e-shopping, a consumer can choose to send an item as a gift, and therefore the address would be one of a non-purchaser. Furthermore, the address data being from a non-purchaser is deemed to be non-functional descriptive material and is not functionally involved in the steps recited. The establishing, managing, accepting, looking up and executing steps would all be performed the same regardless of what type of address it is, whether it be from a purchaser or a non-purchaser. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed.Cir.1994). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Estes to include the capability of collecting and storing multiple addresses for a registered consumer, as disclosed by Franklin in order to decrease the number of times a user has to enter in shipping information for ease of use and to prevent the likelihood that a consumer will mistakenly enter in wrong information (See Franklin, Column 2) (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").

6.   Estes and Franklin discloses the use of unique IDs for different addresses and having an address book, however fails to disclose generating a new unique address identification each time the purchaser requests to purchase or deliver merchandise. Sigler discloses the use of an anonymous shipping transactions where a user can purchase an item and through a third party, generate a unique address ID for each shipping transaction (See abstract). Sigler discloses that

the unique address ID, can be a one-time code, which means a new code is generated each time

the purchaser request shipping. It would have been obvious to one having ordinary skill in the

art at the time the invention was made to modify Estes and Franklin to have the nicknames or

unique addresses IDs be new (one time use) each time a purchase or delivery is requested, as

disclosed by Sigler, in order to increase security (See Sigler, Columns 3 and 4).

7.   With respect to Claims 2 and 13: Estes discloses the use of an elapse of a set length time

that an address ID is good, after that, the ID is deleted from the table (Paragraph 0033), if the ID

is deleted then the correspondence is deleted.

8.   With respect to Claims 3, 4, 14 and 15: Estes discloses that the token has the option of it

only being used a certain number of times before it expires (Paragraph 0033). The examiner

considers this to be fully capable of the number of times being only one. The range that a certain

amount of times" covers, would be inclusive of only one time.

9.   With respect to Claims 5 and 16: Estes discloses the use of registering a user, where a

token has the option of having a set number of times, or set amount of time before expiration, but

fails to disclose the user can request the ID be deleted from the table. IT is old and well known

in the art that a user, when not wanting to pursue an order, or an inquiry, can cancel the order,

cancel the request, unsubscribe, or unregister with a system. This is done on bulk e-mail lists,

there is an "unsubscribe" link, or when a person wants to close out a bank account, they will

close the account and the account is deleted from a table of open accounts. Therefore, it would

have been obvious to one having ordinary skill in the art at the time the invention was made, to

modify Estes, to allow for the user to cancel a token, or unregister with the system, therefore

deleting the address data file, in order to increase security for a user who no longer wants to user or pursue the token or purchase.

10.   With respect to Claims 6 and 17: Estes discloses the use of an address data management method (and system with means for) comprising the steps:

g.   Acquiring delivery address data from a user wishing to purchase an item (Registering, 502 and Paragraph 0026);

h.   Establishing a unique user account for identifying the purchaser (Estes discloses the token can be a unique number, such as the user's account number, Paragraphs 0012 and 0026) according to a request for issuing an address ID from said purchaser (when a user is registered with the system it is a request for the unique address ID, Estes discloses a registration request from the user, reference numeral 502 with corresponding detailed description);

i.   Managing a table between address data and user accounts (Paragraph 0059, the examiner considers the database, to be a form of a table);

j.   Authenticating purchaser using purchasers account (Reference numeral 616, Paragraph 0058), in response to a vendor inquiry (Paragraph 0077) and establishing an address ID and notify vendor of address ID (Estes sends the vendor the shipping lavel with an encrypted barcode, which the examiner considers to be the address IS, Paragraphs 0028, 0036 and 0041);

k.   Accepting delivery request data generated by vendor that includes ID and is obtained by the delivery request of the customer (Paragraph 0081); and

l.   Executing delivery processing based on the delivery address corresponding to

address IS (Paragraph 0081).

11.   Estes however, fails to disclose the acquiring step capable of storing a plurality of

delivery addresses, including addresses of non-purchasers, establishing a unique address ID for

each of the delivery addresses. Franklin discloses the use of a Friendly name finder, in which a

user can enter in a plurality of addresses, each associated with a nickname, which the examiner

considers to be a form of a unique ID, and discloses the nicknames can be for addresses other

than the user's (Figure 9 and 11, Reference numerals 942, 944, 952, 954, 1110, 1112, 1114 and

1110 with corresponding detailed description). This is done all the time when e-shopping, a

consumer can choose to send an item as a gift, and therefore the address would be one of a non-

purchaser. Furthermore, the address data being from a non-purchaser is deemed to be non-

functional descriptive material and is not functionally involved in the steps recited. The

establishing, managing, accepting, looking up and executing steps would all be performed the

same regardless of what type of address it is, whether it be from a purchaser or a non-purchaser.

Thus this descriptive material will not distinguish the claimed invention from the prior art in

terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404

(Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed.Cir.1994).   It would have

been obvious to one having ordinary skill in the art at the time the invention was made to modify

Estes to include the capability of collecting and storing multiple addresses for a registered

consumer, as disclosed by Franklin in order to decrease the number of times a user has to enter in

shipping information for ease of use and to prevent the likelihood that a consumer will

mistakenly enter in wrong information (See Franklin, Column 2) (See KSR [127 S Ct. at 1739]

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").

12.   Estes and Franklin discloses the use of unique IDs for different addresses and having an address book, however fails to disclose generating a new unique address identification each time the purchaser requests to purchase or deliver merchandise.   Sigler discloses the use of an anonymous shipping transactions where a user can purchase an item and through a third party, generate a unique address ID for each shipping transaction (See abstract). Sigler discloses that the unique address ID, can be a one-time code, which means a new code is generated each time the purchaser request shipping. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Estes and Franklin to have the nicknames or unique addresses IDs be new (one time use) each time a purchase or delivery is requested, as disclosed by Sigler, in order to increase security (See Sigler, Columns 3 and 4).

13.   With respect to Claims 8 and 19: Estes discloses the use of transferring the delivery request to user and accepting confirmation information from the user (See Paragraphs 0069, 0070 and 0081).

14.   With respect to Claims 9 and 20: Estes discloses determining if the address ID is valid and determining whether to process delivery based on the determination (See Paragraph 0082).

15.   With respect to Claims 11 and 22: Estes discloses the system capable of settling accounts with the vendor based on information relating to a settlement method (Payment Computer 108, Reference numerals 614 and 616, and Paragraphs 0026, 0028 and 0038).

16.   Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Estes and

Franklin as applied to claims 1, 6 and 17 above, and further in view of Kirner (US

2002/00446040).

17.   With respect to Claims 7 and 18: Estes and Franklin disclose the use of a third party

system for managing delivery addresses. Estes discloses the use of registering a user, but fails to

disclose the use of awarding benefits to users, based on use points, or amount of times the IS is

used. Kirner discloses a system where a user registers with the system, and gains awards based

on the usage of services, based on points and usage (See Paragraph 0060). It would have been

obvious to one having ordinary skill in the art at the time the invention was made, to modify

Estes and Franklin, to include an award system for usage, in order to encourage use of the system

they are registered with. See Kirner Pages 5 and 6.

18.   Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Estes

and Franklin as applied to claims 1, 6 and 17 above, and further in view of Iannacci (US

2002/0062249).

19.   With respect to Claims 10 and 21: Estes and Frankling disclose the use of a method for

managing the delivery of items, however, fails to disclose awarding the vendor each time a

delivery request is received from the vendor. Iannacci discloses the use of a system for assigning

benefits, which provides benefits to all related parties in a purchase transaction (Paragraph 262).

It would have been obvious to one having ordinary skill in the art at the time the invention was

made, to modify Estes and Franklin, to include benefits to the merchant of the transaction, in

order a to allow a merchant to lower product prices which will encourage and assist in the sale of

additional items and enhances the relationship between consumers, merchants and third party

systems. (See Iannacci, Pages 20 and 21)

Response to Arguments

20.   Applicant's arguments with respect to claims 1-23 have been considered but are moot in

view of the new ground(s) of rejection.

Conclusion

21.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629